

## REMARKS

Claims 1-14 have been cancelled and Claims 15-34 have been newly added, leaving Claims 15-34 for consideration upon entry of the present amendment. No new matter has been added by the amendment.

### ***Drawings:***

The text "DECISION TREE" in the box labeled "5" in FIG. 1 has been replaced with the text "DECISION TREE MODULE." This replacement was made to correct an error in the drawing. This is supported in the specification (see, for example, page 5, lines 6-7 and line 9). The reference number "11" has been added to FIG. 2. As described in the specification the decision tree 11 is contained in the decision tree module 5 (see, for example, page 5, lines 14-15). In response to the Examiner's notation that the naming convention in FIG. 2 changes at D(30), Applicant's submit that the naming convention as described in the specification on page 5 at lines 15-17 includes D(#) representing a decision point and R(#) representing a resolution point. In addition, FIGS. 3 and 4 were updated with reference numbers 30 and 40, respectively, to reflect an update made to the specification. No new matter has been added to the drawings.

### ***Specification:***

The specification has been amended to fix typographical errors relating to references to "user 9." As depicted in FIG. 1, the reference number "9" refers to a user access device and not to a user. In addition, the conflict with the image naming convention, as pointed out by the Examiner, has been corrected. No new matter has been added.

The Examiner has stated that it isn't clear how or why the navigation of the tree ends at resolution point R(24) or R(26) and that how the tree is traversed should be detailed in justifying the resolution points. Applicants respectfully disagree with the Examiner because the second and third paragraphs of the Detailed Description of the Preferred Embodiments Section, the first paragraph of the Summary of the Invention section and FIG. 2 provide enough information about how the tree is traversed and when it ends at one of the resolution points so that one of ordinary skill in the art could make and use the invention. The sections describe a decision tree with a plurality of decision points with some of the decision points terminating in a resolution point. In

addition, these sections teach that each of the decision points has an associated query and potential responses associated with the query and that the tree is navigated by selecting between the potential responses. Eventually, a resolution point is reached which includes a diagnosis of the fault. The example given in the third paragraph in the Detailed Description of the Preferred Embodiment includes a query with two potential responses and images associated with a decision point (D(30)). Based on the potential response selected, the tree is navigated to one of two resolution points ((R24) or (R26)). As is known in the art, the exact queries and potential responses will vary based the product whose fault is being diagnosed. Applicants submit that the specification is clear about how and why the navigation of the decision tree ends at particular resolution points and how the tree is traversed. For at least these reasons, Applicants respectfully request the Examiner to withdraw this objection.

In addition, the Examiner has stated that the title of the invention is not descriptive. The title has been amended to recite "System and Method for Remotely Diagnosing Faults." The amended title is believed to be descriptive. Applicants respectfully request the Examiner to withdraw this objection

#### **Claim Rejections under 35 U.S.C. §101**

Claims 1-14 were rejected under 35 U.S.C. 101 because "the disclosed invention is inoperative and therefore lacks utility. Claims 1-14 are not claimed to be practiced on a computer nor are they stored in a computer readable medium." In view of the cancellation of Claims 1-14 and the newly added Claims 15-34, Applicants submit that this rejection is now moot. In addition, Applicants traverse the Examiners statement that "the claimed invention is not support by either a credible asserted utility or a well established utility." Applicants respectfully point out that the claimed invention may be utilized to provide "remote diagnosis and remediation ... while eliminating, or greatly reducing, the need for technical support personnel to actively participate in the technical support process" (see specification, page 7, lines 18-21). For at least these reasons, Applicant's submit that Claims 15-34 are statutory subject matter and therefore in condition for allowance.

#### **Claim Rejections under 35 U.S.C. §112 – first paragraph**

Claims 1-14 were rejected under 35 U.S.C. 112, first paragraph, as "failing to comply with the enablement requirement." The Examiner stated that the "claim(s) contain subject

matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” Applicants respectfully disagree with the Examiner and submit that Claims 15-34 are enabled. For example, the second and third paragraphs of the Detailed Description of the Preferred Embodiments Section, the first paragraph of the Summary of the Invention section and FIG. 2 provide enough information about how the tree is traversed and when it ends at one of the resolution points so that one of ordinary skill in the art could make and use the invention. The sections describe a decision tree with a plurality of decision points with some of the decision points terminating in a resolution point. In addition, these sections teach that each of the decision points has an associated query and potential responses associated with the query and that the tree is navigated by selecting between the potential responses. Eventually, a resolution point is reached which includes a diagnosis of the fault. The example given in the third paragraph in the Detailed Description of the Preferred Embodiment includes a query with two potential responses and images associated with a decision point (D(30)). Based on the potential response selected, the tree is navigated to one of two resolution points ((R24) or (R26)). As is known in the art, the exact queries and potential responses will vary based the product whose fault is being diagnosed. Applicant submit that the Claims 15-34 are enabled because the specification is clear about how and why the navigation of the decision tree ends at particular resolution points and how the tree is traversed. For at least these reasons, Applicants respectfully request that the Examiner withdraw this rejection.

#### **Claim Rejections under 35 U.S.C. §112 – second paragraph**

In view of the cancellation of Claims 1-14 and the newly added Claims 15-34, Applicants submit that this rejection is now moot. For at least this reason, Applicants respectfully request the Examiner to withdraw this rejection.

#### **Claim Rejections under 35 U.S.C. §102**

Claims 1-9 were rejected under 35 U.S.C. 102(b) as being anticipated by Hekmatpour U.S. Patent Number 5,644,686 (July 1, 1997) (“Hekmatpour”). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814

F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants submit that Hekmatpour does not disclose or teach each and every element of newly added Claim 15.

Because they have been canceled, Examiners rejections to Claims 1-14 are moot. However, newly added Claim 15 contains some elements that are similar to elements in canceled Claim 1 and Applicants submit that Hekmatpour does not teach what is recited in Claim 15. The sections of Hekmatpour referred to by the Examiner do not teach “a decision tree having a plurality of decision points each corresponding to one of the fault symptom queries and a plurality of resolution points each corresponding to one of the fault diagnoses” as recited in Claim 15. Column 4, lines 52-64 teach a hierarchically-structured knowledge base for an expert system comprising a ... a plurality of nodes coupled together in three distinct levels and Column 6, lines 1-10 teach a diagnostic expert system for knowledge engineering. This is not the same as a “decision tree having a plurality of decision points each corresponding to one of the fault symptom queries and a plurality of resolution points each corresponding to one of the fault diagnoses”, as recited in Claim 15. For at least these reasons Claim 15 is patentable over Hekmatpour.

In addition, the sections of Hekmatpour referred to by the Examiner do not teach “a plurality of ... fault symptom queries ... wherein each said fault symptom query includes potential responses” and a “decision tree having a plurality of decision points each corresponding to one of the fault symptom queries” as recited in Claim 15. In contrast, Column 12, lines 47-51 of Hekmatpour, as recited by the Examiner recite “[D] describe the reasons, importance, and relevance of each node to its parent node (WHY). Whenever the user requests an explanation of and reason for an action recommended by the system, the system will present the information associated with the current node’s WHY attribute.” This is not the same as “a plurality of ... fault symptom queries ... wherein each said fault symptom query includes potential responses” and a “decision tree having a plurality of decision points each corresponding to one of the fault symptom queries” as recited in Claim 15.

Further, Hekmatpour does not teach “wherein each fault symptom query includes potential responses and images that correspond to the potential responses” as recited in Claim 15. Instead, Column 12, lines 52-55 recite “compile a list of services required at each step during the diagnosis (e.g., display images, play audio or animation, show slide show, present textual or graphics information, etc.)”. Compiling a list of services required at each step, where the list

may include “display images” is not the same as “wherein each fault symptom query includes potential responses and images that correspond to the potential responses” as recited in Claim 15. For at least this reason, Claim 15 is patentable over Hekmatpour.

Because Hekmatpour does not disclose or teach each and every element of Claim 15, Applicant’s submit that Claim 15 is patentable over Hekmatpour. Because they depend from Claim 15, Claims 16-27 are also patentable over Hekmatpour. Because it contains similar features as Claim 15, Claim 34 is patentable for the same reasons that Claim 15 is patentable. Withdrawal of the claim rejections under 35 U.S.C. 102(b) is respectfully requested.

### **Claim Rejections under 35 U.S.C. §103**

Claim 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hekmatpour in view of *Oda* U.S. Patent Number 5,127,005 (June 30, 1992) (“Oda”) and further in view of *Kuji et al* (September 1990) (“Kuji”). Because they have been canceled, the Examiner’s rejection Claims 10-14 is moot. However, newly added Claim 28 contains some elements that are similar to elements of canceled Claim 10 and Applicants submit that Hekmatpour in view of Oda and further in view of Kuji does not teach what is recited in Claim 28. As described above in reference to Claim 15, Applicants submit that Hekmatpour does not teach nor suggest “a decision tree, wherein the decision tree includes a plurality of decision points each corresponding to a fault symptom query and a plurality of resolution points each corresponding to a fault diagnosis, wherein each said fault symptom query includes potential responses and images that correspond to the potential responses and each said potential response in the decision tree indicates one of the decision points or one of the resolution points” as recited in Claim 28. In addition, the rejection of Claim 28 is improper under 35 U.S.C. §103(a) because the Examiner has relied on nonanalogous art in this rejection. See *In Re Wood*, 599 F2d 1032, 202 USPQ 171 (CCPA 1979). More specifically, the Examiner has relied on Oda, which is in the computer chip testing art, in his rejection of the present invention, which is in expert system art. A person of ordinary skill in the expert system art would not look to the computer chip testing art to solve the problem treated by the claimed invention. For at least these reasons Claim 28 is patentable over Hakmatpour in view of Oda and further in view of Kuji. Because they depend from Claim 28, Claims 29-34 are also patentable.

***Conclusion***

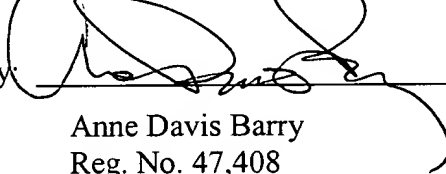
In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130 maintained by the applicants' attorneys.

Respectfully submitted,

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Date: February 25, 2004